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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,062	09/26/2001	Kazuyuki Matsumoto	CU-2676 RJS	1441

26530 7590 02/05/2003

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EXAMINER

WINDMULLER, JOHN

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,062

Applicant(s)

MATSUMOTO ET AL.

Examiner

John Windmuller

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. During a telephone conversation with Richard Streit on 1/14/03 a provisional election was made without traverse to prosecute the invention of Method and apparatus for cutting a sheet-shaped material, claims 1 and 2, drawn to a method for cutting a sheet-shaped material. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3 and 4 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

2. The abstract of the disclosure is objected to because it contains vague and confusing language such as "material heated" on line 3, "a room temperature" on line 5, and "in anticipation" on line 6. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrases "material heated", "a room temperature", and "in anticipation" render the claim vague and indefinite. The meaning of these phrases is not clear. The phrase "thus detected" is confusing because the manner of detection is not previously described. Appropriate correction is required.

In claim 2, the phrases "in anticipation" and "along" render the claim vague and indefinite. The meaning of these phrases is not clear. What is the manner of "anticipation"? Does "along" mean "next to" or "coincident with" or something else?

5. As best understood, claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the. The of Nishigaito describes the same method as claim 1 of the instant application.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. As best understood, claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese patent to Nishigaito (see accompanying English translation of the abstract) in view of Fujita. Nishigaito discloses the invention substantially as claimed except for a sheet shaped workpiece to be cut to produce a sheet shaped product. However, Fujita teaches a sheet shaped workpiece to be cut to produce a sheet shaped product (e.g. 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the method of

cutting including compensation for workpiece thermal expansion of Nishigaito with the sheet shaped workpiece to be cut to produce a sheet shaped product as taught by Fujita.

8. As best understood, claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishigaito in view of Fujita as applied to claim 1 above. The modified device of Nishigaito discloses the invention substantially as claimed except for measuring the temperature of and adjusting the length of several sections of the material to be cut. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of claim 1 by measuring the temperature of and adjusting the length of several sections of the material to be cut, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kudo et al, Morita et al, Diesner.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Windmuller whose telephone number is 703 305-4988.

The examiner can normally be reached on M-F 9-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703 308-1082. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9302 for regular communications and 703 308-9302 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1148.

jw

January 22, 2003



KENNETH E. PETERSON
PRIMARY EXAMINER